REMARKS

The Office Action dated September 17, 2008, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-23 are currently pending in the application, of which claims 1, 8, 14, 18, and 23 are independent claims. Claims 1-23 are respectfully submitted for consideration.

The Office Action rejected claim 23 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleged that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

This rejection is improper because it appears to rigidly analyze the disclosure in view of the precise words "A computer-readable medium encoded with instructions that, when executed on a computer, perform a process." Instead, the appropriate analysis is whether the specification discloses the concept behind the words.

Section 112 of the Patent Act states that the "specification shall contain a written description of the invention." 35 U.S.C. §112. The Federal Circuit has held that "[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The Federal Circuit has explained,

however, that "[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue." *Id. See additionally, Kao Corp. v. Unilever United States, Inc.*, 78 USPQ2d 1257, 1260 (Fed. Circ. March 21, 2006). In other words, there is no requirement that the precise language used in the claims appear in the specification, in order to satisfy the written description requirement. The concept claimed is fully supported in the specification, in such a way that one of ordinary skill in the art could clearly conclude that the inventor invented what is claimed. Therefore, the claims fully comply with the written description requirement.

The concept of "A computer-readable medium encoded with instructions that, when executed on a computer, perform a process" is disclosed for example, in the specification at paragraph [0027] in which there is disclosure of a processor and memory in a typical mobile station. One of ordinary skill in the art would appreciate that the processor and memory in a typical mobile station are for providing "A computer-readable medium [for example, the memory] encoded with instructions that, when executed on a computer [for example, the processor], perform a process ... ."

Furthermore, one of ordinary skill in the art would recognize that the other network elements and functional entities depicted, for example, in Figure 1 of the present application, are typically equipped with "A computer-readable medium [for example, a memory] encoded with instructions that, when executed on a computer [for example, a processor], perform a process ... ." Thus, Figure 1 and the associated discussion in the present application provide full and adequate support for the claim recitations.

Claims 1-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/091785 of Phan-Anh, et al. (referred to as "Bajko et al." in the Office Action) in view of U.S. Patent No. 5,764,730 of Rabe, et al. ("Rabe"). The Office Action acknowledged certain deficiencies of Bajko and cited Rabe to remedy such deficiencies. Applicants respectfully traverse this rejection.

Claim 1, upon which claims 2-7 depend, is directed to a method including detecting that a user equipment has requested a registration to a second serving controller using at least one of a plurality of identities in association with a first serving controller, the plurality of the identities being associated with respective registration statuses selected from a registered status and an unregistered status. The method also includes issuing a registration termination request identifying the at least one of the plurality of identities, which has been newly assigned to the second serving controller as a result of the requested registration. The method further includes, responsive to the registration termination request, issuing a re-registration notification to the user equipment including the at least one of the plurality of identities which has a registered status and which was not assigned to the second serving controller as a result of the requested registration, and disassociating all identities of the said user from the first serving controller.

Claim 8, upon which claims 9-13 depend, is directed to a system. The system includes a first serving controller. The system also includes a user information store configured to hold for a user a plurality of identities in association with the first serving controller, the plurality of identities being associated with respective registration statuses

selected from a registered status and an unregistered status. The system further includes a second serving controller configured to transfer to the user information store a user authentication request identifying the user equipment; and wherein the user information store is configured to detect the user authentication request and to insert into a registration termination request issued to the first serving controller each identity of that user equipment, which was newly associated to the second serving controller as a result of the user authentication request, and wherein the first serving controller is configured, responsive to the registration termination request, to issue a re-registration notification to the user equipment including each identity which has a registered status and which was not assigned to the second serving controller as a result of the user authentication request, and disassociate all identities of the said user equipment from the first serving controller.

Claim 14, upon which claims 15-17 depend, is directed to an apparatus including an interface configured to communicate with a user information store, wherein a plurality of identities, each with respective registration statuses, associate a user equipment with the apparatus. The apparatus is configured, responsive to a registration termination request received from the user information store, to issue a re-registration notification to the user equipment including each identity which has a registered status and which incorrectly associates the user equipment with the apparatus, and disassociate all identities of the said user equipment from the apparatus.

Claim 18, upon which claims 19-22 depend, is directed to a system including storing means for storing in a user information store a plurality of identities in association

with a first serving controller, the plurality of identities being associated with respective registration statuses selected from a registered status and an unregistered status. The system also includes detecting means for detecting that a user equipment has requested a registration to a second serving controller using at least one of said plurality of identities. The system further includes issuing means for issuing a registration termination request identifying the at least one of the plurality of identities, which has been newly assigned to the second serving controller as a result of the requested registration. The system additionally includes notification means for issuing a re-registration notification to the user equipment including the at least one of the plurality of identities which has a registered status and which was not assigned to the second serving controller as a result of the requested registration. The system also includes disassociating means for disassociating all identities of the said user equipment from the first serving controller. The notification and disassociating means are responsive to the registration termination request.

Claim 23 is directed to a computer-readable medium encoded with instructions that, when executed on a computer, perform a process. The process includes detecting that a user equipment has requested a registration to a second serving controller using at least one of a plurality of identities in association with a first serving controller, the plurality of the identities being associated with respective registration statuses selected from a registered status and an unregistered status. The process also includes issuing a registration termination request identifying the at least one of the plurality of identities,

which has been newly assigned to the second serving controller as a result of the requested registration. The process further includes, responsive to the registration termination request, issuing a re-registration notification to the user equipment including the at least one of the plurality of identities which has a registered status and which was not assigned to the second serving controller as a result of the requested registration, and disassociating all identities of the said user from the first serving controller.

Applicants respectfully submit that the combination of Bajko and Rabe fails to disclose or suggest all of the elements of any of the presently pending claims.

Bajko generally relates to subscriber registrations in a mobile communication system. In the method of Bajko, a user can be provided with at least one registration at a first control entity. The at least one registration is transferred to a second control entity in response to another registration of the user to said second control entity. Any of the registrations may expiry in response to expiry of a timer.

The Office Action appears to have admitted that the following features are absent from Bajko:

a) "issuing a registration termination request,"

b) "identifying the at least one of the plurality of identities, which has been newly assigned to the second serving controller as a result of the registration request,"

c) "responsive to the registration termination request, issuing a re-registration notification to the user equipment,"

d) "including the at least one of the plurality of identities which has a registered status"

e) "which was not assigned to the second serving controller as a result of requested registration," and

f) "dissociating all identities of the said user from the first serving controller."

These features are being labeled with letters simply for ease of reference, and for no other reason. No other inferences should be drawn from this use of reference letters. It should be noted that is not entirely clear that the Office Action has admitted that features (a) and (b) are not disclosed in Bajko, since the Office Action has included them prior to the line (at page 3) of the Office Action, which states: "**BAJKO** doesn't teach specifically ..."(bold caps in original). It is believed, however, that this may have been inadvertent as it does not appear that Bajko discloses such features in the cited passages of Bajko (page 11, line 21, to page 14, line 8).

Rabe cannot remedy the deficiencies of Bajko. Rabe generally relates to a radiotelephone having a plurality of subscriber identities and a method for operating the same. It should be noted that Rabe's system is entirely different to that in claim 1. rabe discusses that a user equipment may be registered with different systems at the same time, see column 10, line 12 and following, "all subscriber entities ... registered at once." See also, the bottom of paragraph 9 of Rabe, "the system may allow the radiotelephone to register ... one subscriber identify at a time." It is clear, that claim 1 is diametrically opposed to this, since claim 1 requires a "the at least one of plurality of identities which

has a registered status," which permits multiple registration in direct conflict with the "one subscriber identity at a time" restriction placed on Rabe's system.

Also, in Rabe there is no disclosure of issuing a re-registration notification to the user equipment (features (c) above). One problem with the conventional systems (such as those of Bajko or Rabe) is that the user equipment did not know that it was trying to access a second controller using the identity of a first. Thus, in certain embodiments (as reflected in claim 1), a notification is sent to the user equipment. There is no such notification in Rabe. If the Office disagrees, it is respectfully requested that any future Office Action identify where such a notification is to be found in the cited art.

There is no reference in Rabe to feature (a), above. Rabe talks in general terms about re-registration and de-registration of subscriber entities, but there is no indication in Rabe of

i) "issuing a registration termination request," and

ii) that this request "identif[ies] newly assigned identities,"

as recited in claim 1.

In other words the claimed request is as a direct result of previously detecting that there has been an attempt to register with a second controller, which (as the Office Action appears to have admitted) is not known in Rabe. If there is disagreement, the Office is invited to identify where the feature of issuing the request is found in Rabe. Additionally it is clear from Rabe that there are no newly assigned identities. It is clear from reading Rabe as a whole (which is also how the reference must be read by the Examiner) that

although it is the user equipment which stores user identities, these are fixed and are selectively used to register/de-register in respect to accessing a particular system, as can be seen, for example, from Figure 1 of Rabe.

It should be further noted that there is no reason why the skilled person would attempt to combine Bajko and Rabe. Although it Rabe does relate to user equipment, the controllers are in different telephone systems rather than controller for application/services etc. In other words, the telephony architectures of the two systems are significantly different. Thus, even if a person of ordinary skill in the art were aware of Bajko, there would be no reason to consider Rabe, as there is no reason why (in Bajko) "user equipment would attempt to register to a second controller using at least one of a plurality of identities in association with a first serving controller," as is the case in claim 1. Thus, one of ordinary skill in the art would not be motivated to combine the two references to arrive at the claimed invention.

In summary, therefore, features (a), (b), and (c) are not disclosed either in Bajko and furthermore there is nothing in Rabe to indicate these features. In fact, Rabe would steer one of ordinary skill in the art away from claim 1, as Rabe states that (in column 10, line 12) "radio telephone could perform one registration procedure in which all subscriber identities active in that radiotelephone are registered at once." This shows that feature (c) "issuing re-registration notification **to the user equipment** including the at least one plurality of identities," is not found in Rabe, as it is clear all the subscriber entities are stored in the user equipment (radio).

Claim 1 is therefore navel and inventive. The Office is invited to state particularly where features (a), (b), and (c) are found in either Bajko, Rabe, or any combination thereof, and furthermore why a person of ordinary skill in the art would deem such a combination of features obvious in light of the different systems and system architectures of the cited documents. Since, however, it has been shown that the combination of Bajko and Rabe fails to disclose or suggest all of the features of claim 1, it is respectfully requested that the rejection of claim 1 should be withdrawn.

Independent claims 8, 14, 18, and 23 each have their own respective scope. With respect to each of these claims, however, it is submitted that these claims are novel and non-obvious for at least similar reasons to those discussed above. In any event, the rejection of each of claims 8, 14, 18, and 23 refers to the rejection of claim 1, and thus the rejections of claims 8, 14, 18, and 23 should be similarly withdrawn, and such withdrawal of the rejections is respectfully requested.

Claims 2-7, 9-13, 15-17, and 19-22 depend from and further limit claims 1, 8, 14, and 18, respectively. Thus, each of claims 2-7, 9-13, 15-17, and 19-22 subject matter that is neither disclosed nor suggested in the combination of Bajko and Rabe. It is, therefore, respectfully requested that the rejection of claims 2-7, 9-13, 15-17, and 19-22 be withdrawn.

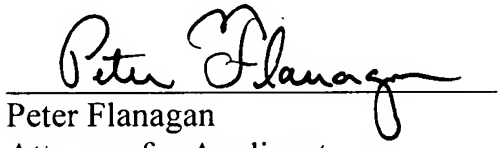
For the reasons set forth above, it is respectfully submitted that each of claims 1-23 recites subject matter that is neither disclosed nor suggested in the cited art, and that the cited art would lead one of ordinary skill in the art away from, rather than toward, the

claimed invention. Thus, it is respectfully requested that all of claims 1-23 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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